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OFFICE OF PETITIONS

In re Application of
Angela C.W. Lai et al.
Application No. 10/644,602
Filed: August 20, 2003
Attorney Docket No: 2500803-900101

: DECISION ACCORDING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the petition filed under 37 CFR 1.47 on June 1, 2004 and supplemented under 37 CFR 1.47(a) on June 10, 2004.

The petition is **GRANTED**.

The above-identified application was filed on August 20, 2003 naming Angela C.W. Lai, James Peter Hoddie, Howard E. Chartock, Christopher V. Pirazzi, Steve H. Chin and Jody Shapiro as joint inventors, but without a signed declaration.

Accordingly, on November 13, 2003, a "Notice To File Missing Parts of Application" was mailed, requiring *inter alia* a properly executed oath or declaration.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

In response, on June 1, 2004, a petition under 37 CFR 1.47(b) was filed with a five month extension of time request and declarations signed only by joint inventors Lai, Chartock, Pirazzi, Chin and Shapiro and signed by Koichi Wada, Manager Intellectual Property Division for SONY, the assignee, claiming that joint inventor Hoddie refuses, by his actions to cooperate with the filing of the application.

Petitioners have shown that the application papers were sent to Mr. Hoddie and that Mr. Hoddie first acknowledged receipt of the application and that he was in the process of reviewing the application and subsequently, petitioners show that follow-up communications to Mr. Hoddie regarding the execution of the oath or declaration have gone unanswered.

Subsequent to the filing of the petition under 37 CFR 1.47(b) on June 1, 2004, petitioner re-filed the petition under 37 CFR 1.47(a). Regarding the treatment of a petitioner under 37 CFR 1.147(b), if none of the named inventor(s) will sign the oath or declaration, a petition under 37 CFR 1.47(b) must be filed. If some of the named inventors signed the oath or declaration and one or more of the named inventors have not signed the declaration, a petition under 37 CFR 1.47(a) must be filed. In the instant case, five of the six inventors had signed the oath or declaration, there was no reason to have Mr. Wada sign on behalf of Mr. Hoddie and thus the petition under 37 CFR 1.47(b) was improvidently filed.

Six separate documents each with a signature of each of the five signing inventors has been submitted, and on each of them, the signature block for Mr. Hoddie has been left blank. In favor of the supplemental petition filed June 10, 2004 under 37 CFR 1.47(a), we will disregard the first page of the oath or declaration signed by the assignee.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the declaration. Notice of the filing of this application will also be published in the Official Gazette.

The application is being forwarded to Technology Center 2171 for examination in due course.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703)305-4497.



Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions



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In re Application of
Angela C.W. Lai et al.
Application No. 10/644,602
Filed: August 20, 2003
For: DISTRIBUTED ON-DEMAND MEDIA
TRANSCODING SYSTEM AND METHOD

Dear Mr. Hoddie:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned Petitions Attorney at (703) 305-4497. Requests for information regarding your application should be directed to the File Information Unit at 703/308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at 703/308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Patricia Faison-Ball
Senior Petitions Attorney
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CC:

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